

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

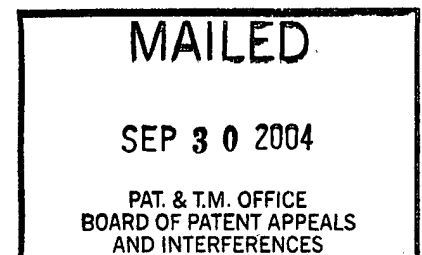
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS DAVID REID FORD and PIERS HARDING

Appeal No. 2004-1353
Application No. 09/493,652

ON BRIEF



Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 through 25. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a mail location apparatus operative to locate a mail item inserted therein at a predetermined location in first and second mutually perpendicular directions. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 24, and 25,

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respective copies of which appear in the APPENDIX to the corrected brief filed December 4, 2004 (Paper No. 21).

As evidence of anticipation and obviousness, the examiner has applied the documents listed below:

Beck et al. (Beck)	4,516,494	May 14, 1985
Salomon	5,640,903	Jun. 24, 1997

The following rejections are before us for review.

Claims 12 through 20, 24, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Salomon.

Claims 21 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Salomon in view of Beck.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 22), while the complete statement of appellants' argument can be found in the brief (Paper No. 21). Based upon appellants' grouping of claims (brief, page 2) and the claims argued in the

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brief, we share the examiner's perspective (answer, page 3) that claims 12 through 15 stand or fall together, that claims 16 through 19 stand or fall together, that claims 20 through 22 stand or fall together, and that each of claims 23, 24, and 25 stand or fall alone. Thus, we focus upon claims 12, 24, 25, 16, 20, and 23, infra.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the Board has carefully considered appellants' specification and claims, the applied teachings,¹ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the Board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Anticipation

We sustain the rejection of claims 12, 16, 20, and 25 under 35 U.S.C. § 102(b) as being anticipated by Salomon, but not the rejection of claim 24. We also sustain the rejection of claims 13 through 15 and 17 through 19 since these claims stand or fall with claims 12 and 16 above, as indicated earlier.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760,

772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S.
1026 (1984).

claim 12

Claim 12 addresses a mail location apparatus operative to locate a mail item inserted thereinto at a predetermined location in first and second mutually perpendicular directions, including, inter alia, a sensor unit including an elongate face² engageable by a mail item, with the face being inclined to both the first and second directions such as to be engaged by the corner of the mail item where the mail item is inserted in a first direction, a second direction, and any direction intermediate thereto.

In our opinion, the projection 19b seen in Fig. 5 of Salomon would be understood by those skilled in the art to encompass an elongated face, i.e., a face that directionally extends for a considerable length, which would be capable of being engageable

² The word "elongate" does not appear in the original disclosure in describing the term "face," and was added to claim 12 (Paper No. 13) subsequent to the filing of the application. Other than the appearance of the face in appellants' drawings, the application provides no understanding of the word "elongate" as a modifier of the term "face." Thus, we comprehend the recitation of an "elongate face" in claim 12 to broadly denote a face that directionally extends for a considerable length.

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by the corner of a mailpiece M whether the mailpiece is inserted in a first direction, second direction, or any direction intermediate thereto, as set forth in claim 12. Thus, the rejection of claim 12 is well founded.

Appellants' argument (brief, page 3) that the projection 19b cannot be characterized as a elongate face fails to convince us that the Salomon teaching is not anticipatory of the content of claim 12, for the reasons articulated above.

claim 24

Claim 24 is drawn to a mail location apparatus operative to locate a mail item inserted thereinto at a predetermined location in first and second mutually perpendicular directions, including, inter alia, a sensor unit including a face inclined to both the first and second directions and engageable by the corner of the mail item, with the face being normally located to extend from adjacent ends of first and second guides across a corner of the predetermined location.

We share appellants' point of view that the second projection 19b of Salomon does not extend from adjacent ends of first and second guides across a corner of a predetermined location, as expressly set forth in claim 24 (brief, page 3). More specifically, it is our opinion that one versed in this art would not readily comprehend from a visual review of Fig. 5 of Salomon that the peripheral extent of projection 19b may fairly be said to extend from adjacent ends of first and second guides 11, 13 across a corner of a predetermined location (opening 31), as claimed. Accordingly, the rejection of claim 24 is not sound.

claim 25

Claim 25 is drawn to a mail location apparatus operative to locate a mail item inserted therein at a predetermined location in first and second mutually perpendicular directions, including, inter alia, sensor unit including a face engageable by the mail item, with the face of the sensor unit being inclined to both the first and second directions such as to be engaged by the corner of the mail item, and extending at least beyond a support platform and reference wall.

Like the examiner, we perceive that one skilled in this art would appreciate from a consideration of Fig. 5 of Salomon that the broadly recited sensor unit arrangement of claim 25 is readable thereon. More particularly, the inclined face of projection 19b can fairly be said to extend along arm 19 at least beyond deck portion 9 (support platform) and either of registration walls 11, 13 (reference walls). As recognized by the examiner (answer, page 12), this broad claim does not require the face to extend vertically beyond the support platform and reference wall, as disclosed.

The argument advanced by appellants (brief, pages 3 and 4) does not convince us that broad claim 25 fails to read on the disclosure of Salomon (Fig. 5) for the reasons explained, supra.

claim 16

Dependent claim 16 sets forth the feature of the sensor unit including an element defining the face that is engageable by the corner of a mail item, with the element being displaceable in a direction inclined to both a first guide wall and a second guide

wall by insertion of the mail item into the predetermined location.

Akin to the examiner's point of view (answer, page 9), it is clear to us that projection 19b (on pivoted arm 19), with its expected operational movement, would address the claimed feature, supra, in the same manner that element 23 (on pivoted lever 25) taught by appellants reads on the content of claim 16.

Appellants' argument (brief, page 4) addressing movement of element (projection) 19b of Salomon along a short arc segment does not convince us that the above reasoning relative to the feature of claim 16 at issue is in error.

claim 20

Claim 20, dependent from claim 12, recites the feature of a support platform for supporting a mail item and a reference wall for referencing the mail item located in the predetermined location, with the face of the sensor unit extending at least beyond the support platform and the reference wall.

While appellants' argument (brief, page 4) quite specifically addresses the underlying disclosure in terms of the jamming problem related to the content of claim 16, the claim language itself is quite broad. Thus, for the same reasons given above relative to comparable language found in claim 25, the subject matter of claim 16 is determined to be fairly readable on the showing in Fig. 5, which reasons are incorporated herein.

Obviousness

We do not sustain the rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Salomon in view of Beck, but do sustain the rejection of claims 21 and 22 since they stand or fall with claim 20, the rejection of which we have sustained above.

claim 23

Claim 23, dependent on claim 12, requires that the face of the sensor unit be inclined at approximately 45 degrees to the first and second directions.

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The difficulty we have with this rejection is that one skilled in the art would not be able to discern from the patent drawing (Fig. 5) in Salomon the actual degree of inclination of the face of the projection 19b. Thus, it would involve pure speculation as to whether the Salomon patent teaches or would have been suggestive of the claimed angle of "approximately 45 degrees." The Beck patent does not overcome this deficiency since it was relied upon by the examiner for other than the teaching of an angle of inclination. It is for these reasons that the rejection of claim 23 cannot be sustained.

In summary, this panel of the Board has sustained the rejection of claims 12 through 22 and 25, but has not sustained the rejection of claims 23 and 24.

The decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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